

REMARKS

Claims 1-3, 5, 8 and 11-15 have been rejected by the Examiner under 35 USC 103(a) as being obvious over U.S. Patent No. 6,541,540 to Hashizume. Claims 1-5, 8, 11, 13 and 15 have been rejected by the Examiner under 35 USC 103(a) as being obvious over U.S. Patent No. 6,203,908 to Chassot. Claim 9 is rejected by the Examiner under 35 USC 103(a) as being unpatentable over Hashizume or Chassot, in view of U.S. Patent No. 5,270,445 to Hou. Claim 10 has been rejected by the Examiner under 35 USC 103(a) as being unpatentable over Hashizume or Chassot, in view of British Patent 2,111,522A to Banba. These rejections are respectfully traversed.

The present invention is directed to a powder metallic coating material comprising a flake pigment and a resin powder which exhibits a high coating brightness, and an excellent substrate hiding property, an effective introduction ratio and a substantial elimination of coating spit formation of the metallic coating material. According to the present invention, the above advantageous results can be achieved by establishing the relationship between the charged value of the flake pigment and the charged value of the resin powder which is defined by the following relationships:

$$|C_R - C_A| \leq 10 \quad \dots \quad (1)$$

$$10 \leq |C_A| \leq 40 \quad \dots \quad (2)$$

where C_A denotes the charge value ($\mu\text{C/g}$) of said flake pigment and C_R denotes the charge value ($\mu\text{C/g}$) of said resin powder.

As can readily be seen by referring to Table 2 of the present application, when $C_R - C_A$ ($\mu\text{C/g}$) is equal to or less than 10 as shown in Examples 1 to 5 of the present application, a very effective introduction ratio (%), a high coating brightness (β/α) a substantial elimination of coating spit formation and an excellent substrate hiding property can be achieved. This is to be compared with Comparative Examples 1 and 2 as shown in Table 2 of the present application,

where it can be readily seen that when $C_R - C_A$ is greater than 10, that is 15.8 and 15.4, respectively, all of the parameters referred to hereinabove, that is, the introduction ratio, the coating brightness, the spit formation and the substrate hiding property were substantially inferior to the present invention. Thus, claim 1 of the present application defines a specific relationship with respect to the charge control agent coated on the surface of the base particle and the charge value of the resin powder which is effective in achieving the Applicant's inventive contribution.

In other words, the characteristic of the present invention lies in finding that the aforementioned excellent effect is achieved only when a powder metallic coating material satisfies the specific charge value relationship defined by expressions (1) and (2) in claim 1 of the present application.

None of the references relied upon by the Examiner disclose or even remotely suggest the specific charge value relationship defined by the expressions (1) and (2) in claim 1 of the present application. On page 3 of the Examiner's Office Action letter the Examiner specifically states that the Hashizume reference is silent with respect to the charge value relationship between the pigment and the resin as set forth in claims 1 and 15 of the present application. Similarly, on page 4 of the Examiner's Office Action letter, the Examiner also concedes that the Chassot reference is silent with respect to the charge value relationship between the coated pigment and the resin as set forth in claims 1 and 15 of the present application. In spite of this deficiency, the Examiner has taken the position that since the charge value difference is determined by the charge value of the resin in the charge value agent themselves, which is a property of the resin and charge value agent, the claimed value difference would be inherent in the Hashizume and Chassot references, absent clear evidence to the contrary.

To establish a *prima facie* case of obviousness, the Examiner must show that the prior art references, that is, the Hashizume reference and the Chassot reference provide some teaching, suggestion or motivation which would make the prior art references relevant with respect to the powder metallic coating material as defined by the claims of the present application. First of all,

the prior art references do not even remotely suggest or contemplate the importance of the relationship between the charge value of the flake pigment and the charge value of the resin powder. Lacking such a teaching or suggestion clearly adversely affects the motivation in relying upon the teachings of the Hashizume and Chassot references. Since the prior art references do not even remotely contemplate the importance of the relationship between the charge value of the flake pigment and the charge value of the resin powder, it is understandable that the prior art references do not appreciate the specific relationship between the charge value of the flake pigment and the charge value of the resin powder as set forth in expressions (1) and (2) as recited in claims 1 and 15 of the present application. Thus, the prior art references do not appreciate the importance of the charge value relationship *per se* and furthermore cannot appreciate that the charge value relationship must fall within specific parameters as defined by expressions (1) and (2) as recited in the claims of the present application.

Furthermore, when relying on the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily follows from the teachings of the applied art. See, Ex parte Levy, 17 USPQ2d 1461, 1464 (BD. Pat. App. & Int. 1990). There can be no speculation or only possibilities involved in a holding of inherency. What is alleged to be inherent must necessarily occur. The mere fact that something may result from a given set of circumstances is not sufficient. In re Oetric, 212 USPQ 323, 326 (CCPA 1991). “Inherent anticipation requires that the missing descriptive material is necessarily present; not merely probably or possibly present, in the prior art.” Trintec Indus. Inc. v. Top-U.S.A. Corp, 295 F-3d, 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting In re Robertson, 169 F-3d 743, 745, 49 USPQ2d, 1949, 1950-51 (Fed. Cir. 1999).

In connection with the rejections of claims 9 and 10, since the Hou reference in connection with claim 9 and the Banba British reference, do not correct the deficiencies of the Hashizume or Chassot references, it is believed that claims 9 and 10 are patentable over the prior art relied upon by the Examiner for the same reasons as claims 1 and 15 of the present application.

Specifically, none of the references relied upon by the Examiner disclose or suggest the specific charge value relationship defined by expressions (1) and (2) recited in claims 1 and 15 of the present application. The powder metallic coating relationship of the present invention satisfies the specific charge value relationship defined by expressions (1) and (2), thereby achieving the excellent effect as can be found by referring to page 8, line 8 to page 9, line 6 of the present application. In other words, the characteristics of the present invention lie in finding that the aforementioned excellent effect is achieved only when a powder metallic coating material satisfies the specific charge value relationship defined by expressions (1) and (2) as recited in claims 1 and 15 of the present application. Accordingly, one skilled in the art cannot readily arrive at the excellent results achieved by the present invention, based upon the references which do not teach or suggest the importance of the charge value relationship or the specificity of the charge value relationship as defined by expressions (1) and (2) and accordingly there cannot be any motivation for rejecting the claims of the present application based upon these deficiencies.

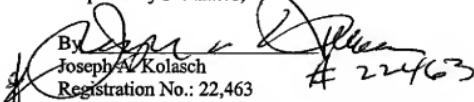
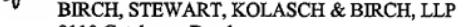
Accordingly, in view of the above remarks reconsideration of the rejections and allowance of all the claims of the present application are respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Joseph A. Kolasch Reg. No. 22,4763 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

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Respectfully submitted,


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